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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,900	02/25/2005	Claude Pommerau	1606.72574	9652
24978 7590 06/24/2010 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER BUTLER, MICHAEL E				
ART UNIT		PAPER NUMBER		
3653				
MAIL DATE		DELIVERY MODE		
06/24/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/525,900
Filing Date: February 25, 20055
Appellant(s): Claude Pommereau

Christopher S. Hermanson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/29/2010 appealing from the Office action mailed 4/14/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,549, 518 Wang 07-1989

US 5,624,325 Smith 10-2007

US 3, 738,662 Hodgin 11-2000

(9) Grounds of Rejection

Claim Rejections - 35 USC § 112

Claims 1, 7-8, 15-16, and 28-29 are rejected under 35 U. S. C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has conjoined elements using “OR” (claim 1 final line) creating vague and indefinite language as to the scope of the claim protection sought- sought-alternate embodiments or a device capable of reconfiguration for sans counterweight or sans return spring. The claims have been otherwise examined on the merits presuming Boolean “OR.”

Applicant has further created indefiniteness as to the precedence of the nesting of “without” vs. the OR operator-is applicant attempting to claim without a

counter weight or is presence of the counterweight an alternative to without a spring?

Claim Rejections - 35 USC § 102

Claim(s) 1, 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang 5549518 which discloses all the claimed elements including: a golf ball dispenser comprising: an upper container to contain golf balls (2), flange (12, 34, 3) to receive the balls coming from the container (c2 L 35-45) a pivotal supply arm (32), pivoting means (31) arranged in the upper end of the dispenser arm to close the flange (when pivoted to the down position 34 moves into the ball blocking position), without a return spring or a counterweight (4), arm comprising a brake for accurate depositing of the golf ball (322), the brake, comprising a bend (322).

Claim(s) 1, 7-8, are rejected under 35 U.S.C. 102(b) as being anticipated by Smith 5624325 which discloses all the claimed elements including: a golf ball dispenser comprising: an upper container to contain golf balls (46), flange (18,46) to receive the balls coming from the container (40) a pivotal supply arm (20), Pivoting means (48) arranged in the upper end of the dispenser arm to close the flange (when pivoted about 48, 72 is positioned to block plural balls moving;C5L

18-28; c5 L 60-c6 L 14), upper arm comprises a means for singulating balls in dispenser arm (70; c6 L 7-10), the means comprising a rim arm (70; c6 L 7-10).

Claim(s) 1 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hodgin 3738662 wherein the Smith discloses the elements previously discussed and Hodgin 3738662 discloses any elements not inherently taught by the former including: plural non-concentric rings for slowing down the drop of the ball, the distance between consecutive rings decreasing closer to the arm lower end (band ring 80, wire rings at end of arm-bend in path so non-concentric),

It would have been obvious at the time of the invention for Smith to use rings to slow the ball and avert the ball bouncing off the arm or tee as taught by Hodgin.

Claim(s) 1 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang 5549518 in view of Hodgin 3738662 wherein the Wang discloses the elements previously discussed and Hodgin 3738662 discloses any elements not inherently taught by the former including: plural non-concentric rings for slowing down the drop of the ball, the distance between consecutive rings

decreasing closer to the arm lower end (band ring 80, wire rings at end of arm-bend in path so non-concentric).

It would have been obvious at the time of the invention for Wang to use rings to slow the ball and avert the ball bouncing off the arm or tee as taught by Hodgins.

(10) Response to Argument

Applicant's precedence on the nesting of "without" and "OR" together creates indefinite language as to which operator has precedence in satisfying the Boolean operation in constructing the claim scope and applicant's use of the OR operator leaves ambiguity on whether applicant is claiming alternate embodiments, a reconfigurable dispenser with differing return means.

The applicant's arguments have been fully considered but they are unpersuasive in overcoming the indefiniteness rejection.

The operators are not commutative when used together so their sequential application results in differing results from the Boolean equation used in constructing the claim scope. Such alternative construction sequence can sometimes result in some opposite element composition satisfying the Boolean equation relative the opposite sequence.

Further, applicant's attempt at negative limitations by saying what he is not claiming rather than what he is claiming improperly leaves the public uncertain as to what is claimed. Applicant needs affirmatively cite what invention he is claiming rather than what he is not claiming.

One needs make the decision on indefiniteness on the present claimset as amending the claim at some future time may change art issues. As applicant's language might be inserted within the claim at a plurality of places, it is entirely possible it might yet result in indefinite language. The determination needs be made on the present claimset and applicant has alternatives to appeal if he has not yet finalized his claim preference and prefers to amend the claims.

Wang anticipates claims 1 and 15-16 as Wang has a pivot in the upper end of the arm and Wang is without a spring.

The applicant's arguments have been fully considered but they are unpersuasive in overcoming the prior art rejection.

Wang has a pivot in the upper end of the arm whenever the arm is in the dispensing position. Applicant points to a figure in the rest position only. However, when in the arm is in the dispensing position as shown in figure 4, the pivot 31 is in the upper position of the arm. A dispensing position orientation is a

better position orientation that a rest position is certainly a better position to determine whether the pivot is in the upper portion of the arm as the dispense position features the Pivot. However, merely one position satisfying the requirement that the pivot is in an upper portion of the arm is sufficient to meet the claim limitation.

Wang satisfies the Boolean of without a return spring. Wang uses a counterweight to return the arm. Wang returns the arm without a return spring as included in the left side of the “OR” operator. A reference needs satisfy only one side of the Boolean operator “OR” to satisfy and meet the limitation.

If the OR operator is applied after the without, a counterweight present satisfies the right hand side of the equation. Therefore, under at least one additional interpretation of the Boolean operator prioritization, Wang satisfies the right hand side of the Boolean equation of having a counterweight further meeting the claim limitation.

Smith anticipates claims 1 and 7-8 as Smith has a pivot in the upper end of the arm and Smith is without a counterweight.

The applicant’s arguments have been fully considered but they are unpersuasive in overcoming the anticipatory rejection evidenced by Smith.

Smith has a pivot in the upper end of the arm whenever the arm is in the dispensing position. Applicant points to a figure with the arm in the rest position only. However, when in the arm is in the dispensing position as shown in figure 2, the pivot 48 is in the upper position of the arm. A dispensing position orientation is a better position orientation that a rest position is certainly a better position to determine whether the pivot is in the upper portion of the arm as the dispense position features the Pivot. However, merely one position satisfying the requirement that the pivot is in an upper portion of the arm is sufficient to meet the claim limitation.

Wang satisfies the Boolean of without a counterweight. Smith uses a counterweight to return the arm. Smith returns the arm without a counterweight as included in the right side of the “OR” operator. A reference needs satisfy only one side of the Boolean operator “OR” to satisfy and meet the limitation.

Wang in view of Hodgkin obviates the claimed invention as Hodgkin features a plurality of rings with the rings closer the lower end of the arm being closer to one another than the upstream ring.

The applicant’s arguments have been fully considered but they are unpersuasive in overcoming the rejections evidenced by Wang in view of Hodgkin.

As disclosed in Fig. 5 & 6, Hodgin features a dispenser with a band style ring 38 upstream and further downstream proximate the lower end of the arm are two unlabeled wire type rings. The wire rings are close together with larger significant gap between the wire rings and the band ring. Any impact of the ball to the wire will result in the effect of slowing the ball down.

Smith in view of Hodgin obviates the claimed invention as Hodgin features a plurality of rings with the rings closer the lower end of the arm being closer to one another than the upstream ring.

The applicant's arguments have been fully considered but they are unpersuasive in overcoming the rejections evidenced by Smith in view of Hodgin.

As disclosed in Fig. 5 & 6, Hodgin features a dispenser with a band style ring 38 upstream and further downstream proximate the lower end of the arm are two unlabeled wire type rings. The wire rings are close together with larger significant gap between the wire rings and the band ring. Any impact of the ball to the wire will result in the effect of slowing the ball down.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Summary

As applicant has created ambiguity in his claim scope through the use and mixing of the operators “OR” and without, the rejections under 35 U.S.C. §112 second paragraph ought be affirmed.

As Wang teaches a dispensing arm with a pivoting means in the upper portion of the arm and teaches a return or the arm without a return spring the anticipatory rejection ought be affirmed. As Smith teaches a dispensing arm with a pivoting means in the upper portion of the arm and teaches a return or the arm without a counterweight the anticipatory rejection ought be affirmed. As Hodgkin teaches a plurality of rings with the rings near the lower end of the arm closer together, the rejections under 35 U.S.C. §103 ought be affirmed.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Saúl J. Rodríguez/

Supervisory Patent Examiner, Art Unit 3652

Conferees:

Art Unit: 3653

Michael E. Butler /M. E. B./

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Saul. Rodriguez /SJR/

David Okonsky /DO/